

Via EFS
Date of Deposit: September 7, 2010

Attorney Docket No. 24024-505 CON
(GE Ref. No.: 26691)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Peled, *et al.*

CONF. NO. : 9770

SERIAL NUMBER : 10/774,843

EXAMINER : Maria Gomez Leavitt

FILING DATE : February 9, 2004

ART UNIT : 1633

FOR : EXPANSION OF RENEWABLE STEM CELL POPULATIONS

Via EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181

1. Applicants request reconsideration of the Advisory Action mailed August 17, 2010 (“Advisory Action”) and specifically request withdrawal of the Office’s decision in the Advisory Action to not consider and not enter the claim amendments and the 37 C.F.R. § 1.132 Declaration of Dr. Tony Peled (“Declaration”) filed with Applicants July 30, 2010 Response (“Response”) to the Final Office Action mailed April 30, 2010 (“Final Office Action”).

2. Under the requirements set forth in 37 C.F.R. § 1.181, the following statement of facts and the point or points to be reviewed and the action requested are submitted herewith in support of this Petition:

2.1 The decision not to enter and consider the claim amendments proposed in the Response is based on the Examiner’s assertion that the additional limitations in the independent claims were not previously examined and required a new search (*See*, Advisory Action at point 3 on page 2 and cont. of point 3 on page 3). Applicants submit that this assertion is incorrect. Rather, Applicants submit that the subject matter of the amendments made in independent claims 401 and 411 encompass the subject matter of dependent claims 464 and 465; and as such, these amendments were previously examined by the Office and do not require a new search (*See*, Response at pages 2-4). Additionally, Applicants submit that these amendments place the claims

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in better condition for consideration on appeal in accordance with 37 C.F.R. § 1.116(b)(2). For these reasons, Applicants respectfully request that the Office enter and consider the July 30, 2010 claim amendments.

2.2 The decision not to enter and consider the Declaration of Dr. Tony Peled under 37 C.F.R. § 1.132 filed with the Response is based on the Examiner's assertion that the after-final Declaration is not directed to a new rejection first made in the Final Office Action but rather to the 35 U.S.C. § 103 rejection previously of record. (*See*, Advisory Action at point 11 on page 2 and cont. of point 11 on page 3). Applicants submit that this assertion is incorrect. Rather, 37 C.F.R. § 1.116(e) provides that an affidavit or other evidence submitted after a final rejection may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not presented earlier. Applicants submit that such good and sufficient reasons are present here. Specifically, Applicants submit that the July 2010 Declaration of Dr. Peled was specifically directed to the Examiner's dismissal of a February 2010 Declaration of Dr. Peled and the Examiner's assertion, for the first time, in the Final Office Action that the evidence presented in that February 2010 Declaration was not statistically significant (*See*, Final Office Action at page 8). That is, the data/evidence provided in the July 2010 Declaration was not generally directed to the 35 U.S.C. § 103 rejection previously of record as asserted by the Examiner; but rather, evidence submitted to directly rebut the Examiner's statements first made in the Final Office Action (*See*, Response at page 7). As such, Applicants respectfully submit that the July 2010 could not have been presented earlier and is necessary to support the evidence provided in the February 2010 Declaration. For these reasons, Applicants respectfully request that the Office enter and consider the July 30, 2010 Declaration of Dr. Tony Peled under 37 C.F.R. § 1.132.

3. Under the requirements set forth in 37 C.F.R. § 1.181, the following exhibits are submitted herewith in support of this Petition:

- 3.1 Copy of the Advisory Action mailed on August 17, 2010 (3 pgs);
- 3.2 Copy of Applicants Amendment and Response to Final Office Action and Declaration of Dr. Tony Peled under 37 C.F.R. § 1.132 filed July 30, 2010 (15 pgs);
- 3.3 Copy of the Final Office Action mailed April 30, 2010 (12 pgs);

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4. Under the requirements set forth in 37 C.F.R. § 1.181, this petition is filed within two months of the August 17, 2010 mailing date of the Advisory Action from which relief is requested. As such, Applicants submit that this petition is timely filed and respectfully request consideration of the foregoing.

5. Under the requirements set forth in 37 C.F.R. § 1.181, no fee is believed to be due. However, the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 24024-505 CON.

6. Applicant respectfully request that the Office withdraw the Examiner's findings in the August 17, 2010 Advisory Action and enter and consider the claim amendments and the Declaration of Dr. Tony Peled under 37 C.F.R. § 1.132 submitted with Applicants July 30, 2010 Response to Final Office Action mailed April 30, 2010.

Respectfully submitted,

/ Matthew Pavao /

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